

1 WILLIAM L. ANTHONY (State Bar No. 106908)  
2 ERIC L. WESENBERG (State Bar No. 139696)  
3 HEIDI L. KEEFE (State Bar No. 178960)  
4 ORRICK, HERRINGTON & SUTCLIFFE, LLP  
5 1000 Marsh Road  
Menlo Park, CA 94025  
Telephone: 650-614-7400  
Facsimile: 650-614-7401

6 STEVEN ALEXANDER (admitted *Pro Hac Vice*)  
7 KRISTIN L. CLEVELAND (admitted *Pro Hac Vice*)  
8 JAMES E. GERINGER (admitted *Pro Hac Vice*)  
JOHN D. VANDENBERG  
KLARQUIST SPARKMAN, LLP  
One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, OR 97204  
Telephone: 503-226-7391  
Facsimile: 503-228-9446

12 Attorneys for Defendant and Counterclaimant,  
13 MICROSOFT CORPORATION

14 UNITED STATES DISTRICT COURT  
15 NORTHERN DISTRICT OF CALIFORNIA  
16 OAKLAND DIVISION

17 INTERTRUST TECHNOLOGIES  
18 CORPORATION, a Delaware corporation,  
Plaintiff,  
19 v.  
20 MICROSOFT CORPORATION, a  
Washington corporation,  
Defendant.

22 MICROSOFT CORPORATION, a  
Washington corporation,  
Counterclaimant,  
23 v.

25 INTERTRUST TECHNOLOGIES  
26 CORPORATION, a Delaware corporation,  
Counter Claim-Defendant.

CASE NO. C01-1640 SBA

MICROSOFT CORPORATION'S  
PATENT LOCAL RULE 4-2  
DISCLOSURE OF PRELIMINARY  
CLAIM CONSTRUCTION AND  
EXTRINSIC EVIDENCE (LIMITED  
TO "MINI-MARKMAN" CLAIMS)

28

MICROSOFT CORPORATION'S PATENT LOCAL  
RULE 4-2 DISCLOSURE (LIMITED TO "MINI-  
MARKMAN" CLAIMS), CASE NO. C 01-1640 SBA

1 Pursuant to Patent Local Rule 4-2 and this Court's Order, entered November 5, 2002,  
2 Defendant Microsoft Corporation ("Microsoft") hereby serves its "Disclosure Of Preliminary  
3 Claim Construction And Extrinsic Evidence," limited to the twelve selected "Mini-Markman"  
4 patent claims. Microsoft's preliminary claim construction is based upon the proposed terms,  
5 phrases and clauses, and claims as a whole, identified by the parties in their submissions in  
6 accordance with Patent Local Rule 4-1(a) and conference in accordance with Patent Local Rule 4-  
7 1(b).

8 Microsoft provides its preliminary claim construction of each of the 12 "Mini-Markman"  
9 claims subject to the limitations and reservations of rights set forth herein. Microsoft does not  
10 waive any defenses that the asserted claims fail to satisfy the provisions of 35 U.S.C. § 112  
11 including, for example, the written description requirement, the definiteness requirement, or any  
12 other requirement for patentability. Microsoft does not concede that the asserted claims are  
13 supported by Plaintiff's original application or any application from which they purportedly claim  
14 priority. Specifically, by offering a construction of a term, Microsoft does not waive any defense  
15 that the claim is in fact indefinite and there can be no proper construction.

16 Microsoft provides its preliminary claim construction in the following format. Exhibit A  
17 sets forth Microsoft's preliminary construction of (1) the claim term "virtual distribution  
18 environment" ("VDE"), (2) the "VDE invention" disclosed in the February, 1995, InterTrust  
19 patent application, and (3) certain other claim terms. Exhibit B sets forth Microsoft's preliminary  
20 construction of the disputed claims as a whole, and particular claim phrases in dispute, in the  
21 order of appearance in a claim. Where an individual claim term (within a phrase) is also in  
22 dispute, it will be bold-faced in Exhibits A and B. Exhibit C sets forth Microsoft's preliminary  
23 construction of the individual terms in dispute, in alphabetical order.

24 Microsoft reserves the right to modify its preliminary claim constructions in the event that  
25 the parties are unable to agree upon a particular claim construction. Furthermore, because  
26 InterTrust has not yet fully complied with the disclosure requirements of Patent Local Rules 3-1  
27 and 3-2, Microsoft expressly reserves the right to amend its preliminary claim construction if  
28

1 evidence becomes available through those disclosures (or that should have been provided therein)  
2 that would support amended constructions. Microsoft further reserves the right to amend its  
3 preliminary claim constructions once it has an opportunity to review InterTrust's preliminary  
4 claim constructions and once the parties have further met and conferred as required.

5

6 Preliminary Identification of Evidence in Support of Claim Construction

7 Microsoft's preliminary claim construction is supported by the intrinsic record of the  
8 seven U.S. patents from which the 12 "Mini-Markman" claims are selected. For the purposes of  
9 submission of this preliminary claim construction only, Microsoft treats the "intrinsic" evidence  
10 as including: 1) the specifications of each of the seven U.S. patents at issue in the "Mini-  
11 Markman" proceeding, including any material purportedly incorporated by reference therein;  
12 2) the prosecution history of each of the seven patents at issue, including the applications and  
13 prosecution history of the seven patents and any related patent applications, including without  
14 limitation, applications purportedly incorporated by reference or to which an application claimed  
15 priority; and 3) all references cited in the prosecution of any such applications. In accordance  
16 with the local rules, this evidence is not specifically identified, except to the extent that Microsoft  
17 asserts particular sections of a patents' specifications provide "structure" for claims properly  
18 construed under 35 U.S.C. § 112(6).

19 In certain circumstances, Microsoft's preliminary construction may be supported by  
20 extrinsic evidence presently available to Microsoft. Microsoft reserves the right to modify or  
21 supplement with evidence that it has not yet been able to fully review, due to InterTrust's  
22 production, including without limitation, InterTrust re-production of over 1,000,000 pages on  
23 November 4, 2002. Microsoft reserves the right to supplement with additional evidence gathered  
24 in the course of the discovery collected between now and the close of "claim construction"  
25 discovery or later submitted by InterTrust in full compliance with its disclosure obligations under  
26 Patent Local Rules 3-1 and 3-2. Extrinsic evidence is identified or produced in accordance with  
27 the local rule and set forth in the following exhibits:

28

1 Exhibit D: Contains copies of excerpts from dictionaries and other publications. Due to  
2 the volume of the appended pages, Exhibit D will be served via Federal Express.

3 Exhibit E: Contains a list of selected production documents, identified by initial bates  
4 number.

5 Exhibit F: Contains a list of selected, uncited prior art publications, identified by bates  
6 number(s).

7 Exhibit G: Contains a list of selected, uncited prior art patents, identified by bates  
8 number(s).

9 In addition to the extrinsic evidence cited in Exhibits D-G, Microsoft incorporates by  
10 reference herein and reserves the right to rely upon: 1) all documents identified by InterTrust in  
11 response to discovery or pursuant to the Patent Local Rules; 2) all InterTrust patents,  
12 publications and other things that are prior art to any Mini-Markman claim; and 3) the testimony  
13 of InterTrust and the witnesses identified below.

### Preliminary Identification of Witnesses<sup>1</sup>

**Professor John Mitchell:** Dr. Mitchell will testify of the following matters:

17 1) that certain of the presently disputed terms and phrases used in the twelve claims are  
18 amorphous terms lacking a well-defined, precise meaning that can accurately be gleaned from  
19 technical or other dictionaries. Rather, these terms are used in the art and/or in the patents in a  
20 manner that requires close consideration of the entire patent specification to put them in proper  
21 context and determine their precise, correct meaning as used in the patents. These terms include  
22 "secure container," "control," "govern," "protect," "protected processing environment," "secure,"  
23 "securely," "security," "virtual distribution environment";

24 2) that the concepts stated in the InterTrust patents were known to the art, including the  
25 cited prior art, which cited art he will describe;

<sup>27</sup> <sup>1</sup> In accordance with the local rules, Microsoft identifies witness testimony that it contends will support its construction. It has not identified herein testimony relevant to the “tutorial” to be held prior to the claim construction hearing.

1           3) the level of skill, background, and understanding (including extent thereof) of the  
2 relevant patent application disclosures by a person of skill in the art; and  
3           4) the meaning and scope certain disputed claim language, including "secure container,"  
4 "control," "govern," "protect," "protected processing environment," "secure," "securely,"  
5 "security," and "virtual distribution environment."

6           Professor David Maier: Dr. Maier will testify on the following matters:

7           1) what the February 13, 1995, patent application (SN 08/388,107) and the seven  
8 InterTrust patents, described as the "invention," more particularly, what are the required,  
9 necessary, non-optional features of the "VDE" "invention" as stated in the patents. This  
10 description will include an explanation of the features set forth in Microsoft's "Global  
11 Constructions" (Exhibit A).

12           2) what the February 13, 1995, patent application (SN 08/388,107) and the seven  
13 InterTrust patents, required as necessary, non-optional building blocks to implement the "VDE"  
14 "invention" as stated in the patents.

15  
16           Dated: December 20, 2002

17  
18           By:   
19

20           WILLIAM L. ANTHONY  
21           ERIC L. WESENBERG  
22           HEIDI L. KEEFE  
23           ORRICK HERRINGTON & SUTCLIFFE, LLP  
24           1000 Marsh Road  
25           Menlo Park, CA 94025  
26           Telephone: 650-614-7400

27           STEVEN ALEXANDER  
28           KRISTIN L. CLEVELAND  
29           JAMES E. GERINGER  
30           JOHN D. VANDENBERG  
31           KLARQUIST SPARKMAN, LLP  
32           One World Trade Center, Suite 1600  
33           121 S.W. Salmon Street  
34           Portland, OR 97204  
35           Telephone: 503-226-7391

1  
2 Attorneys for Defendant  
3 MICROSOFT CORPORATION  
4

5 Of Counsel:  
6

7 T. Andrew Culbert, Esq.  
8 Microsoft Corporation  
9 One Microsoft Way  
10 Building 8  
11 Redmond, WA 98052-6399  
12 Telephone: 425-882-8080  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**DECLARATION OF SERVICE BY E-MAIL**

I am more than eighteen years old and not a party to this action. My place of employment and business address is 121 S.W. Salmon St., Suite 1600, Portland, OR 97204.

On December 20, 2002, at 3:00 p.m., I served on counsel for InterTrust Technologies Corporation:

**MICROSOFT CORPORATION'S PATENT LOCAL RULE 4-2  
DISCLOSURE OF PRELIMINARY CLAIM CONSTRUCTION AND  
EXTRINSIC EVIDENCE (LIMITED TO "MINI-MARKMAN" CLAIMS)**

by email delivery to:

<p>Michael H. Page, Esq.  John W. Keker, Esq.  Jon B. Streeter, Esq.  Keker &amp; Van Nest, LLP  710 Sansome Street  San Francisco, CA 94111  Telephone: 415-391-5400  Facsimile: 415-397-7188  Email: <a href="mailto:mhp@kvn.com">mhp@kvn.com</a></p>	<p>Douglas Derwin  InterTrust Technologies Corporation  4800 Patrick Henry Drive  Santa Clara, CA 95054  Telephone: 408-855-0100  Facsimile: 408-855-0144  Email: <a href="mailto:dderwin@intertrust.com">dderwin@intertrust.com</a></p>
<p>Steven H. Morrisett, Esq.  Finnegan Henderson Farabow  Garrett &amp; Dunner  Stanford Research Park  700 Hansen Way  Palo Alto CA 94304-1016  Telephone: 202-408-4000  Facsimile: 202-408-4400  Email: <a href="mailto:steven.morrisett@finnegan.com">steven.morrisett@finnegan.com</a></p>	

I declare under penalty of perjury that the foregoing is true and correct.

Executed on December 20, 2002, at Portland, Oregon.

(SIGNATURE)

Kristin L. Cleveland

**(PRINT NAME)**